



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,327	02/14/2000	Dr. Steven Ericsson Zenith	KPI 2	7756

7590

06/10/2005

Dr. Steven Ericsson Zenith
1077 Clematis Drive
Sunnyvale, CA 94086

EXAMINER

BAYERL, RAYMOND J

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,327

Applicant(s)

ZENITH, DR. STEVEN ERICSSON

Examiner

Raymond J. Bayerl

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The amendment filed 25 August 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows: Please note that the large quantities of amendatory material appearing at page 3, paragraph 2; page 5, paragraph 5 – page 6, paragraph 3; page 27, paragraph 2 – page 28, paragraph 1; page 37, paragraph 3 – page 38, paragraph 1 are embellishments upon the original specification filed 14 February 2000 that do not correspond directly to what was previously presented. These amount to new matter, and are objectionable under 35 USC 132(a).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 – 17 are rejected under 35 USC 112, first paragraph because there was no written description in the original specification for such amended material as that noted above, in the objection under 35 USC 132(a). The claims are therefore based upon an improper specification and rejected under this ground.

Since claims are to be read in light of the disclosure, a disclosure applicant obviously felt would benefit from the new matter embellishments, they attempt to gain a

standing with the amendment that is based upon a written description that was not in fact originally filed on 14 February 2000.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 - 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claim 6, the phrase "such as" at line 9 does not clearly set forth just how similar the intended comparable devices might be.

At claims 9, 12 - 13, applicant claims an invention in which "user privacy" or "anonymity" "is protected" and a system that is "non-privacy invasive". However, it is unclear how a market-data collection system that considers individual user interactions with the programming categories can have such a property. While the user may not as readily *suspect* that privacy is being invaded, the fact remains that it is, internal to the system.

It is appreciated that applicant has attempted to remedy this situation by now reciting that this is "by virtue of the affinity character proxy", but it still leaves language such as "non-privacy invasive" unclear. It may well be that a "character proxy" is involved, but to call the resultant invention non-invasive would still not be properly understood, since user data is in fact collected while the user interacts.

7. Claims 1 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. ("Herz"; US #6,088,722) in view of Bingham et al. ("Bingham"; US #5,799,298).

As in independent claim 1's provision of "affinity based categorization of internet or television content", Herz similarly provides for the receipt of **desired** movies and other forms of data from a network (Abstract), according to characteristics in use for characterizing video programming, these to include film genres such as westerns, comedies, dramas, foreign language, etc. as defined by the American Film Institute (col 11, line 41 - col 12, line 6), so that the characteristics of content predict the attractiveness of each video program, movie, or other data to each prospective customer. Thus, Herz, working with "a universe of content", has the end result of returning desired content, and a "virtual" channel is created to receive the program selected to match that customer's interests (col 48, lines 18 - 34). This establishes the affinity that the customer has, as regards the kinds of programming that may be provided.

While the dialog conducted with the Herz customer will discover characteristics relating to a profile, initially obtained according to several ways, such as by zip code or other characteristic demographic information or by monitoring what customers watch (col 12, lines 7 - 58), Herz does not **explicitly** show a "character emblematic of a specific category", "wherein each character is associated with and mediates a subset of the universe of content".

However, the selection of a graphical "affinity group character" occurs in the system for establishing pattern matching and differentiation disclosed in Bingham. In particular, the user is given a choice of one of the characters such as are shown in fig 3, these having differing profile definitions (col 4, lines 13 - 52), with the computer user determining and indicating who are they **most like** (col 3, lines 9 - 40).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to represent choices in profile definition, useful to Herz's customization, in the form of pre-defined characters as per Bingham because this creates a more friendly and intuitive interface for the specification of that content the user is ultimately interested in viewing, by the introduction of Bingham's human character metaphors.

As per claim 2's "content" that "is filtered", please note that both Herz and Bingham are concerned with producing a filtered subset of the original content collection available, and in the combination, it would be "through the affinity group character". This "defines broadcast media and Internet content which is available for viewing" (claim 3) and in Herz, such "broadcast programming" is subject to "targeting" "to a desired audience" (claim 4; see also claim 14). In particular, Herz discusses application to home shopping selections, infomercials and the like (col 4, lines 39 - 65), as in claim 5's "advertising content".

Independent claim 6 is similar in many ways to independent claim 1 and therefore rejected for many reasons similar to those given above. Also in claim 6 is a "feedback means...for storing character / user interaction information", this being used "for determining allocation of advertising". However, at least in Herz, **feedback** is obtained for updating the customer profiles in accordance with the video programming actually watched by the customer (col 6, line 43 - col 7, line 4), so that the ongoing use of the Herz selection mechanism also provides "feedback" to adapt the interface. As

further suggested by Herz, "advertising" then becomes customized on the basis of what the user does in the interface. See also claims 10, 11, 17.

As for claim 7's "interaction information", which "includes" "times each affinity group character is selected, time viewers spend interacting with each character, number of users selecting each character", these are all features of the frequency with which the characters are selected in Bingham. Herz, also, acquires profile information to such an extent by noting the video programming actually watched. Thus, both the original and ongoing communications and choices of the user in each system are used to determine the content presented.

Claim 8's "characters history of interactions with a user" reads upon Herz in view of Bingham for similar reasons. The Bingham user can establish "a virtual relationship" with the "affinity character" he or she is most like, with the goal that "repetition is avoided and content related to the interactions can be identified and presented later", as one might expect in such a custom viewing arrangement.

As per claims 9, 12, 13, to the extent that "privacy" is "protected" and not invaded by the claimed invention's collection of "feedback" and tracking of "interactions", a similar point can be made concerning both Bingham, with the metaphoric characters, and Herz, with the user dialogue and programming analysis, that shield some of the information-gathering of the invention from the end user and thus create an appearance, at least, of "privacy".

As per claim 15, any system using the type of server found at the information head-ends of Bingham or Herz will have "means for selecting and storing broadcast content for later playback".

Independent claim 16 is similar to independent claim 1 and is rejected for reasons similar to those given above. Also, in Herz in view of Bingham, the use of the characters shown in Bingham "relates to and further amplifies the broadcast and media content" presented in conjunction with the "selected character". Anything made user-specific is essentially "amplified" to that user.

8. Applicant's arguments filed 25 August 2003 have been fully considered but they are not persuasive.

Concerning the lack of clarity in reciting that "privacy" and "anonymity" are protected in claims 9, 12, 13 (see above rejection under 35 USC 112, second paragraph), applicant argues (page 9) that the use of "an aggregate proxy" creates an invention that "mediates perfectly well without this knowledge", and "without knowing any other detail about them" and that "a secondary system of information" would be needed to perform such an inquiry. However, the claims on their own merits do not have this quantity of distinction read in and they remain unclear.

As per the rejection under 35 USC 103 that is based on Herz in view of Bingham, while applicant notes (page 11) that "common broad problem statements are addressed by these disclosures", it is applicant's position that "the means, methods and mechanisms of the solution that each provide is different". However, after careful reconsideration of the claims, and as they have been amended, the Examiner is unable

to find, within the actual recitations of the claims themselves, the kind of differences that would avoid reading upon the customization of content as per Herz that uses affinity characters with which the user identifies, as per Bingham.

Applicant attempts to distinguish the claimed invention, for example, at pages 12 – 13 by arguing that “No profile or identity of individual users is required or maintained”. However, this does not keep references such as Herz or Bingham from reading on the actual claims, which have no mention of such a distinction. A similar line of reasoning applies to applicants attempt to distinguish the claimed invention at page 13 by noting that “no computational processing of set data (Herz and Bingham) or other search methods or search refinement processing mechanisms (Kayahara) or user input (Khoo US#6,434,747) is required to determine the mapping of content to affinity”. It simply remains that affinity characters are used in Bingham to mediate a universe of content such as is provided by Herz, and the Examiner is not permitted to “read in” this level of distinction as might be seen from the full disclosure.

At pages 16 – 17, applicant argues that “Herz use of AFI categorization, in particular, does not correspond to affinity categorization but is, rather, genre categorization. Our categorization is not bound in this way or constrained by, or dependent on, predefined categorization”. However, it remains that the claimed invention simply uses affinity characters such as are then suggested by Bingham, in order to represent categories of content such as might be provided by Herz. To find a user’s preferences in a system like Herz’s is indeed a form of “affinity” determination; the user has an affinity for the genre, so this attempt to form a distinction is not

persuasive. It is also the case, as applicant argues at page 17, that applicant's invention is used for "developing an affinity intended to be a close match to the targeted user".

In arguing "[t]hat Bingham is also a character based interface is only a superficial similarity" (pages 18 – 19), applicant attempts to establish a difference between the Bingham "'most like' correspondence" and the "more natural 'emblematic' (claims 1, 6) identification found everyday between a user and friends, colleagues, mentors and heroes". However, the term "emblematic" does not in fact occur in these claims, but more importantly, the "most like" determination in user association with a Bingham character is sufficient to read upon the user identification via affinity with ~~the~~ a character that is used in the present claims. RB

It is appreciated that the "character" applicant attempts to establish (pages 20 – 21) as being in use in the claimed invention has characteristics that are inherent to that character, and not to ones that the system must instead attempt to adapt via user dialogue as corresponding to the user. However, the claims themselves do not bear out such distinction, and in any event, the Bingham characters have their own custom identities that do not require development from user information.

Applicant argues at page 23 that "there is an obvious mismatch between Herz and Bingham, since Bingham requires a predetermined characterization and Herz cannot predict the characterization". However, it is not seen how a difference like this would mitigate against the combination of the two references, and thus the obviousness of the claimed invention. Herz categorizes content and Bingham provides character

Art Unit: 2173

associations from which the user may select. The Examiner deems that there is sufficient analogy and motivation for the combination.

Applicant's response continues with arguments based upon observations related to the overall specification and disclosure, where it has been demonstrated that the claims themselves do not distinguish over the Herz/Bingham combination. While it is appreciated on the Examiner's part that a quantity of development and consideration must certainly underlie the overall disclosure and invention that has been presented, a claim must in fact stand on its own merits, and during the course of examination, be subjected to a reasonably broad interpretation that is consistent with and in light of that disclosure, but without undue readings-in. The Examiner has carefully considered the claims in this way, on their own merits, and simply does not observe specific language in the claimed use of affinity based characters to moderate subsets of a universe of content that will distinguish sufficiently over the combination of Herz and Bingham.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 2173

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173

2 June 2005